

REMARKS/ARGUMENTS

The present response is being filed within two (2) months after the mailing date of the final rejection.

Claims 10-25, 35 and 36 remain in the application.

5 Claims 35 and 36 are currently amended.

Claim Rejections Under 35 U.S.C. § 102

Claims 21 and 35 were rejected under 35 U.S.C. § 102(b) over US Patent 922,858 to Conley.

10 The applicant respectfully points out that claim 35 is amended herein to use the transitional phrase "consisting of" in place of either "consisting essentially of" or "comprising."

15 It is settled law that the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.").

20 Here, the transitional phrase "consisting of" clearly distinguishes Conley, which teaches a "book clasp" (see, e.g., title) structured for "holding an account book in a closed position, so that bills and other loose papers may be held in the book." Lines 20-23 (emphasis added). The book clasp has a bar corresponding in "length" to a "width" of a book. See, e.g., claim. A band of elastic material is connected at both ends (see, e.g., Figure) to the ends of the bar and extended around the book. See, e.g., claim and Figure. The elastic band is connected to the bar by rivets. Lines 50-53. The means for attaching the elastic band may be other than rivets "so long as they perform their proper functions." Lines 62-65.

25 For at least the above reasons, the invention as recited in claim 35 is clearly not anticipated by the book clasp of Conley and is clearly allowable thereover. Reconsideration and allowance are respectfully requested.

Moreover, the book clasp of Conley fails to anticipate the elastic retainer having at least one of the first and second ends being "releasably" anchored to the support bar, as recited in claim 35. Rather, Conley only teaches elastic band being unreleasably connected to the bar. Conley

teaches the elastic band being connected to the bar by rivets. Lines 50-53. Obviously, rivets can only connect the elastic band unreleasably to the bar.

Furthermore, Conley teaches the elastic band may be attached by other "means" than rivets. But such other "attaching means" still must unreleasably connect elastic band to the bar because the other "attaching means" still must "perform their proper functions." Lines 62-65. The only function of the rivets or other attaching means disclosed by Conley is fixedly attaching the elastic band to the bar.

The only disclosed means for removing the elastic band is if it should "break in use." Lines 59-62. Thus, the only means for removing the band is by destruction, which clearly renders the book clasp device unsatisfactory for its intended function of holding bills and other loose papers in the book. Obviously, it cannot be taught to remove the elastic band by destruction.

Therefore, the rivets or other attaching means must unreleasably connect elastic band to the bar because that is the only function disclosed by Conley.

Accordingly, Conley clearly does not anticipate the elastic retainer having at least one of the first and second ends being "releasably" anchored to the support bar, as recited in claim 35.

For at least the above additional reasons, the invention as recited in claim 35 is clearly not anticipated by the book clasp of Conley and is clearly allowable thereover. Reconsideration and allowance are respectfully requested.

Claim 21 is allowable at least as depending from allowable claim 35.

Claim 21 is further allowable independently of allowable base claim 35 as reciting the elastic retainer including "releasable anchors on each of its first and second ends." As discussed above, in contrast to the "releasable" anchors recited in claim 21, the rivets or other attaching means must unreleasably connect elastic band to the bar because that is the only function disclosed by Conley.

For at least the above additional reasons, the invention as recited in claim 21 is clearly not anticipated by the book clasp of Conley and is clearly allowable thereover. Reconsideration and allowance are respectfully requested.

Claims 36, 10, 11, 14 and 18 were rejected under 35 U.S.C § 102(b) over US Patent 2,645,197 to Jones.

The applicant respectfully points out that claim 36 is amended herein to use the transitional phrase "consisting of" in place of either "consisting essentially of" or "comprising."

Here, the transitional phrase "consisting of" clearly distinguishes Jones, which teaches a "book marker" (see, e.g., title) which includes a back member 12 that telescopes to fit the

5. "height" of spines of different books. Lines 39-49. Several "page separating cords" 30 extend from a hook 20 at one end of the back member 12 and attach to a row of notches 36 in a rack 24 at the opposite end. Column 2, lines 20-34. When in use, the back member 12 is aligned with the spine of the book, the upper end at the back of the book is engaged by the hook 20 and the tongue 26 is inserted as far as possible into the [lower end] of the book. Column 2, lines 7-40.
- 10 The several book page separating cords 30 are "interposed between the book pages." Column 2, lines 40-43. Thus, the book marker 10 is satisfactory for its intended function of facilitating the convenient and expedition opening of a book at several different passages. Column 1, lines 1-6.

- For at least the above reasons, the invention as recited in claim 36 is clearly not anticipated by Jones and is clearly allowable thereover. Reconsideration and allowance are respectfully
15. requested.

- The book page separating cords 30 of Jones cannot anticipate the "resilient elastic retainer" recited in claim 36. The examiner's arguments based on dictionary definitions of "resilient" and "elastic" are utterly specious. If all "cords" are "resilient," then even iron is "resilient" because it is capable of being hammered back into an original shape or position. If all
20. "cords" are "elastic," then even iron is "elastic" because it is capable of being hammered back into an original shape. However, the examiner cannot be intending to make such arguments.

- Therefore, at least because iron cannot be reasonably portrayed as "resilient" or "elastic," neither can the "cord" 30 of Jones. To be "resilient" the cord 30 would have to be "marked by the ability to recover readily" or "capable of returning to an original shape or position, as after being
- 25 compressed." Obviously, the cord 30 of Jones has neither "ability." Rather, the cord 30 cannot return itself to its original shape or position, but must be returned by some outside force. Therefore, the cord 30 is not "resilient."

- Additionally, to be "elastic" the cord 30 would have to be "a flexible stretchable fabric made with interwoven strands of rubber or an imitative synthetic fiber, or an object made of this
- 30 fabric, or a rubber band. Obviously, Jones does not teach the "cord" 30 as being any of the above.

Alternatively, the "cord" 30 would have to be "easily resuming original shape after being stretched or expanded; flexible, or springy; rebounding." Obviously, the cord 30 of Jones cannot "return" to its original shape after being stretched or expanded. Rather, if stretched or expanded, a "cord" as taught by Jones will just stay the altered stretched or expanded shape upon release, unless forced back into the original shape by outside forces. It is not "springy" or "rebounding" because it naturally retains its altered stretched or expanded shape upon release. We know this because the "cord" 30 is a "cord." It is not an "elastic band" because if it was an "elastic band," Jones would have taught it as being an "elastic band." But Jones did not teach the "cord" 30 as being an "elastic band." Rather, Jones taught the "cord" 30 as being exactly a "cord" and nothing else.

Since the "cord" 30 of Jones is not "resilient" and is not "elastic," what is it? A "cord" is "a slender length of flexible material usually made of twisted strands of fibers and used to bind, tie, connect, or support." See, e.g., "cord" at YAHOO!® Education (copy previously provided, see response to previous Official Action). Obviously, nothing in this definition suggests that the "cord" is either "resilient" or "flexible." Thus, the "cord" of Jones does not teach any "resilient elastic retainer," as recited in claim 36.

For this additional reason, the book marker of Jones is not "inherently" capable of supporting the book as recited in claim 36.

For at least the above additional reasons, the invention as recited in claim 36 is clearly not anticipated by the book marker of Jones and is clearly allowable thereover. Reconsideration and allowance are respectfully requested.

Claims 10, 11, 14 and 18 are allowable at least as depending from allowable claim 36.

Claims 19-20 and 25 were rejected under 35 U.S.C §.102(b) as being unpatentable over reference 2002-127642 to Sato.

Claim 19 uses the limiting transitional phrase: "consisting of," which limits the elements to those set forth in the claim.

However, claim 19 has been consistently examined as if it used the "consisting essentially of" transitional phrase recited instead in claims 35 and 36. Therefore, these claims have been improperly examined as being equivalent to "comprising."

Here, the transitional phrase "consisting of" clearly distinguishes Sato, which teaches a page control implement having main parts A(1) and B(2) connect on a hinge (3), two elastic bands (4) and (6) are attached to opposite ends of a transparent band (5). A fixed board (7) is attached to an end of elastic band (6) with a stuck surface fastener (8) on the back of the other
5 end of the fixed board (7), and stuck surface fastener (8) is fastened to a prepared surface fastener (9) in the other end of main part B(2). See, e.g., Claim 1.

For at least the above reasons, the invention as recited in claim 19 is clearly not anticipated by Sato and is clearly allowable thereover. Reconsideration and allowance are respectfully requested.

10. Claim 25 is allowable at least as depending from allowable claim 19.

Claim 20 differs in scope from allowable claim 19. However, claim 20 also recites the limiting phrase "consisting of." Therefore, the above arguments and reasons for allowance directed to claim 19 are sufficiently applicable to claim 20 as to make repetition unnecessary. Thus, for each of the reasons above, claim 20 is believed to be allowable, and reconsideration and allowance
15 are respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over 6 US Patent 2,645,197 to Jones in view of US Patent 922,858 to Conley...

20 Claim 13 is allowable at least as depending from allowable claim 36, and reconsideration and allowance are respectfully requested.

Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over 6 US Patent 2,645,197 to Jones in view of US Patent 6,453,589 to Schwartz.

25 Claim 15 is allowable at least as depending from allowable claim 36, and reconsideration and allowance are respectfully requested.

Claims 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over 6 US Patent 922,858 to Conley in view of US Patent 4,555,128 to White.

Claims 22-24 are allowable at least as depending from allowable claim 35, and
5 reconsideration and allowance are respectfully requested.

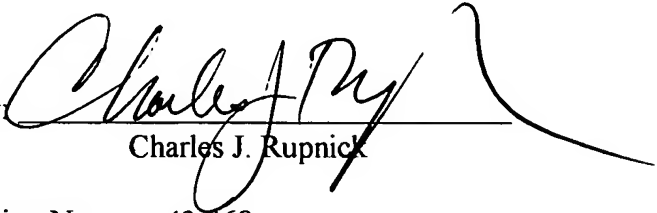
The claims now being in form for allowance, reconsideration and allowance is respectfully requested.

10 If the Examiner has questions or wishes to discuss any aspect of the case, the Examiner is encouraged to contact the undersigned at the telephone number given below.

Respectfully submitted,

15

Attorney


Charles J. Rupnick

20

Registration No.: 43,068
Date: February 26, 2007
Post Office Address: PO Box 46752
Seattle, WA 98146
Telephone: (206) 439-7956
Facsimile: (206) 439-3223